REMARKS

The Examiner is thanked for the performance of a thorough search. Claims 1-11 and 13-22 are pending in this application.

Claims 1-4, 9-11 and 13-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,031,904 to An ("An") in view of U.S. 6,219,790 to Lloyd, et al. ("*Lloyd*") and further in view of U.S. Patent No. 6,173,438 to Kodosky, et al. ("*Kodosky*").

Claims 5-8 and 19-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *An,* in view of *Lloyd*, and further in view of U.S. Patent No. 6,622,016 to Sladek ("*Sladek*").

In this response, Claims 1, 2, 5, 9 and 16-18 have been amended. The amendments to the claims are merely to clarify features, and do not require a new search of the prior art. No claims have been canceled or added.

I. REJECTION OF THE CLAIMS UNDER 35 U.S.C. § 103(a)

In order to establish a *prima facie* case of obviousness, three criteria must be met: (1) the prior art reference, or combination of references, must teach or suggest all of the claim limitations; (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; and (3) there must be a reasonable expectation of success. (MPEP §2142). None of these criteria are met in the present case.

A. There Is No Motivation To Modify Or Combine The Cited References

***The Office Action does not provide a motivation to combine An and Kodosky, and
one skilled in the art would not be motivated to modify An to include a privilege token***

As stated by the Court of Appeals for the Federal Circuit, "[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of hindsight syndrome where that which only the inventor taught is used against its teacher." W.L. Gore & Assocs v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir 1983). The Federal Circuit has recently reiterated that "the tests of whether to combine references need to be applied rigorously." McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). Broad, conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." (McElmurrary v. Arkansas Power & Light Col., 995 F.2d 1576, 1578, 27 USPQ2d 1129 1131 (Fed. Cit. 1993)), and a general relationship between fields of the prior art references is insufficient to suggest the motivation to combine such references (see In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)).

Guided by the foregoing principles, the Office Action statement that "[i]t would have been obvious for one of ordinary skill in the art to use a privilege token method of validation inasmuch as … it is merely one of a plurality of well known methods of validation" does not meet the standard for an obviousness rejection under 35 U.S.C. §103(a).

The stated goals are so general and vague that they cannot rationalize the specific invention that is claimed. It is well-settled that "[i]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior

art so that the claimed invention is rendered obvious" and that "[o]ne cannot use hindsight

reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the

claimed invention." (In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992);

quoting In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

It appears that impermissible hindsight was used to generate the foregoing statement

of motivation.

***The fact that references can be combined or modified is not sufficient to establish
prima facie obviousness***

"The mere fact that references can be combined or modified does not render the

resultant combination obvious unless the prior art also suggests the desirability of the

combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a

prior art device "may be capable of being modified to run the way the apparatus is claimed,

there must be a suggestion or motivation in the reference to do so." *id,* 916 F.2d at 682, 16

USPQ2d at 1432. In addition, the fact that the claimed invention is within the capabilities of

one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness.

MPEP 2143.01, citing Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter 1993).

The level of skill in the art cannot be relied upon to provide the suggestion to combine

references. Al-site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

The Office Action does not state any specific motivation found in *An,* or in the

knowledge generally available to one of ordinary skill in the art, for *An* to use a privilege

token. The Office Action merely states that "a token method of validation ... is merely one

of a plurality of well known methods of validation." Even if a privilege token were one of a

plurality of well known methods of validation, which it is not, that is not sufficient motive to

use a privilege token in *An*.

The Office Action statement that "it would not affect the operation or teach away

from the service provisioning aspect of An et al. inasmuch as the validation process is a

separate one from the provisioning process" also does not provide any motivation to combine

the references, merely that they could be combined.

An teaches that an authentication server validates a user's right to modify services for

a specified DN (Distinguished Number) through the use of a password or PIN Personal

Identification Number), or some other mechanism. (*An,* Col. 7, lns 50-54). While there are

many various authentication methods, such as passwords and PINs, that can be used to

authenticate a user in *An*, there is no motivation to specifically use a privilege token that

includes subscriber privilege information associated with the subscriber as an authentication

mechanism.

An would require substantial redesign to arrive at the claimed invention

An obviousness rejection also is not appropriate if substantial reconstruction or

redesign of the prior art references is necessary to arrive at the invention, as is the case with

the cited references. (See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In the claimed invention, different users can have different access privileges. Such a

system wherein different users are associated with different privileges is said to provide

"differentiated services." For example, in a system that provides differentiated services, one

subscriber may be allowed to subscribe to services A, B and C, another subscriber may only

have privileges to subscribe to services A and B. In contrast, in *An*, any user can subscribe to any service.

In one embodiment, a privilege token is used in the claimed invention to provide differentiated services. As *An* does not provide differentiated services, *An* would not be motivated to use a privilege token as a method of authentication, as *An* has no use for the additional subscriber privilege information stored in a privilege token. None of the cited references convey or suggest a privilege token that includes subscriber privilege information. The system of *An* would have to be substantially redesigned in order to provide for a privilege token that includes subscriber privilege information.

Furthermore, if the system of *An* were to be modified to include a privilege token as a method of validation, many unnecessary changes would be needed to the system to implement the privilege token. For instance, a privilege token associated with the subscriber that includes subscriber privilege information would need to be generated. When a simple password or PIN method of authentication is sufficient for validation, as in *An,* there is no motivation to use a privilege token that would require an additional step to generate a token. This is especially true as the token in the claimed invention includes subscriber privilege information. There is no motivation in A*n* or any other cited reference to store unused information in a privilege token. The significant redesign of *An* to include a privilege token when differentiated services are not even provided plainly shows that the references lack motivation to combine.

As the Office Action states, there are many well known methods of validation. A person skilled in the art would have no motivation to seek out a new method of authentication that requires additional information.

An and Kodosky cannot be combined because they are not analogous art

It is improbable that one skilled in the art of managing telephone services subscriptions would look to the art of embedded graphical programming techniques for a suggestion or motivation with respect to validating or authenticating a user. As stated in MPEP 2141.01(a), "[t]he examiner must determine what is 'analogous prior art' for the purpose of analyzing the obviousness of the subject matter at issue... In order to rely on a reference as a basis for refection for an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."

Here, the claimed invention concerns managing wireless network service subscriptions. *Kodosky* is concerned with providing a flexible programming environment that allows users to design virtual instrumentation applications. The graphical programs created using the system of *Kodosky* can be downloaded to an embedded system for execution in a real-time manner. The teachings of *Kodosky* are not at all pertinent to the problem of managing wireless network service subscriptions.

In a case in which a combination of two references were used in support of an obviousness rejection, the Federal Circuit state that "[t]he combination of elements from non-analogous art sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must

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be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Therefore, In re Oetiker stands for the proposition that it is not proper to combine non-analogous prior art. One skilled in the art of managing wireless network service subscriptions would not find a motivation or suggestion to turn to the *Kodosky* reference for any reason, much less to add an unnecessary privilege token to the a service that does not provided differentiated services..

For all the foregoing reasons, a *prima facie* case of obviousness has not been established. Accordingly, reconsideration and withdrawal of the rejection of claims 1-11 and 13-22 under 35 U.S.C. § 103(a) is respectfully requested.

B. The Cited References Do Not Teach Or Suggest All Of The Claim Limitations

Even if there was motivation to combine the references, which there is not, the cited references do not teach or suggest all of the claim limitations.

A Privilege Token that includes subscriber privilege information associated with a subscriber is not taught or suggested by Kodosky

The Office Acton states that the privilege token recited in independent claims 1, 5, 9, 16, 17 and 18 is taught by *Kodosky* at Fig. 16 and Col. 20, lines 10-39. However, *Kodosky* does not actually teach a privilege token as used in the claimed invention. *Kodosky* teaches that tokens, as a general concept, can be used to arbitrate who has read/write privilege to different fields of a shared memory block when bi-directional channels are used.

The token in *Kodosky* is a generic token used to determine which user currently has read/write privileges. In *Kodosky,* token "owners", as shown by FIG. 16, can read or write

data at any time. Users who are not current owners of tokens have more limited read-only

privileges.

The value of the token in *Kodosky* is determined by the current "owner" of the token.

When a user "owns" the token, the user is allowed both read and write access to a data area.

After the user that "owns" the token has written information to the data area, the user can

then pass the token to a second user. The second user will then "own" the token, and have

privilege to write to the shared data area. By only allowing one user at a time to "own" the

token, *Kodosky* ensures that concurrent conflicting writes to the same data area do not occur.

In contrast, the privilege token recited in claims 1, 5, 9, 16, 17 and 18 includes

"subscriber privilege information." This subscriber privilege information is used to

determine whether the subscriber associated with the privilege token has privileges sufficient

to carry out the requested modification (claims 1, 5, 16, 17, 18), or to automatically log into

subscribed services (claim 9). The generic token taught by *Kodosky* does not include any

information at all, much less subscriber privilege information.

None of the cited references teach or suggest storing privilege and service information in a directory repository

Claim 13 recites the step of:

> generating a list of only those telecommunications services for which the
> subscriber has a privilege to subscribe to, *based on privilege information and
> service information that is stored in the directory repository and associated
> with the subscriber*, said privilege information associated with the subscriber
> specifying what telecommunications services the subscriber has privileges to
> subscribe to;

None of the cited references teach or suggest storing privilege information and

service information associated with a subscriber in a directory repository. The Office Action

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asserts that "the feature profiles are stored locally either on service 50, machine 52, as well as in profile repository 18" as taught by *An* teaches this limitation. This is an incorrect reading of *An.*

Col. 3, lines 27-34 of *An* teaches that "the profile repository for a given service manager is a memory storage allocation which may be stored on the respective service manager node on the machine which implements the features or on some other intermediate machine." This does not teach generating a list of only those telecommunications services for which the subscriber has a privilege to subscribe to *based on privilege information and service information that is stored in the directory repository and associated with the subscriber* as recited in Claim 13. *An* only teaches storing profiles in a repository. *An* does not teach or suggest storing privilege information and service information associated with a subscriber, much less storing this information in a *directory* repository.

Conclusion

In addition to the above-discussed limitations, each of the dependent claims introduces one or more additional limitations that independently render it patentable. However, in view of the patentability of the independent claims, the dependent claims are not further argued at this time to expedite prosecution.

In view of the foregoing, it is respectfully submitted that Claims 1-11 and 13-22 are patentable over the cited references. Accordingly, reconsideration and withdrawal of the rejection of Claims 1-11 and 13-22 under 35 U.S.C. § 103(a) is respectfully requested.

It is respectfully submitted that all of the pending claims are in condition for

allowance and the issuance of a notice of allowance is respectfully requested. If there are

any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner

believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

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on   July 7, 2005   by